



1614

Socket No. 17327CIP

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Pacifici et al.)	Examiner:	Fay, Z.
)		
U.S. Serial No.:	09/552,823)		
Conf. No.:	3454)	Group/Art Unit:	1614
Filed:	April 20, 2000)		
)		
For:	USE OF RETINOID RECEPTOR)		
	ANTAGONISTS OR AGONISTS)		
	IN THE TREATMENT OF)		
	CARTILAGE AND BONE)		
	PATHOLOGIES)		
)		

REPLY TO OFFICE ACTION

Commissioner for Patents
Alexandria, VA 22313-1450

Dear Sir:

Applicants are in receipt of the Office Action mailed October 7, 2003 and have the following comments.

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CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the United States Postal Service first class mail in an envelope addressed to: Mail Stop
Amendment-Fee, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Date Mailed: 2/5/2004

Printed Name: BONNIE FERGUSON

Date of Signature: 2/5/2004

Name: Bonnie Ferguson

Docket: 17327CIPCPA2 (HL)
Serial No. 09/552,823

itself contains abundant evidence to rebut a *prima facie* holding to the contrary. To this end, Applicants point out that on page 21 the disclosure of the present application contains, as incorporated by reference, the disclosure of 33 patents that disclose the structures of literally millions of retinoid receptor agonists. Furthermore, the term "retinoid receptor agonist", particularly in light of the specification, is a well known phrase to those of skill in the art. A cursory search of the term "retinoid receptor agonist" conducted by the undersigned using the PubMed abstract database reveals 147 hits representing publications having a publication date of 1999 or earlier and containing these terms in their abstracts alone. Thus, clearly the skilled worker was abundantly familiar with this term at the priority date of the present application.

Given these facts, Applicants respectfully maintain that there is no precedent in the case law or the Guidelines for the holding that the present claims violate the written description requirement, and ask the Examiner to reconsider and withdraw this ground of rejection.

Lack of Antecedent Basis

The currently pending Office Action also rejected claim 6 under 35 USC 112, second paragraph as reciting a "retinoid receptor antagonist". This was a typographical error; claim 6 has now been amended to recite a "retinoid receptor agonist".

For these reasons the Applicants respectfully request reconsideration and withdrawal of this rejection. Please use Deposit Account 01-0885 for the payment of the extension fee and any other fee due.

Respectfully submitted,


Carlos A. Fisher, Reg No. 36,510

Legal Department, T2-7H
ALLERGAN, INC.
2525 Dupont Drive
Irvine, CA 92612
Telephone: (714) 246-4920
Fax: (714) 246-4249